UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _07 October 2010_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _11,14,15,17,20,21 and 23_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _11,14,15,17,20,21 and 23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1   **DETAILED ACTION**

2

3   This action is in response to the communication filed on 10/7/10.

4   All objections and rejections not set forth below have been withdrawn.

5   Claims 11, 14, 15, 17, 20, 21, and 23 are pending.

6

7   *Continued Examination Under 37 CFR 1.114*

8

9   A request for continued examination under 37 CFR 1.114, including the fee set

10   forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

11   application is eligible for continued examination under 37 CFR 1.114, and the fee set

12   forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

13   has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/7/10

14   has been entered.

15

16   *Specification*

17

18   The specification is objected to as failing to provide proper antecedent basis for

19   the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

20   of the following is required:

21   The specification fails to provide proper antecedent basis for the recitations of

22   "…a public switched telephone network that is distinct from the packet-oriented data

1   network…" (e.g. claims 11 and 23). The examiner notes that there is no discussion

2   within the applicant's originally filed disclosure of the notion of a packet-oriented data

3   network as "distinct" from a public switched telephone network. Rather, the examiner

4   notes that the applicant's originally filed disclosure explicitly admits to the fact that the

5   claim recitation of a "public switched telephone network" is a reference to packet-

6   oriented data networks, such as a digital ISDN (e.g. see specification, par. 13; see also

7   par. 25). As the applicant clearly shows the recited "public switched telephone network"

8   to be a packet-oriented data network, the examiner notes that there appears to be no

9   basis for the applicant's present recitations for a distinction.

10

11   *Claim Rejections - 35 USC § 112*

12

13   **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

14   The specification shall contain a written description of the invention, and of the manner and process of
15   making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
16   art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
17   set forth the best mode contemplated by the inventor of carrying out his invention.
18
19   **Claims 11, 14, 15, 17, 20, 21, and 23 are rejected under 35 U.S.C. 112, first**

20   **paragraph, as failing to comply with the written description requirement.** The

21   claim(s) contains subject matter which was not described in the specification in such a

22   way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

23   time the application was filed, had possession of the claimed invention. Applicant has

24   not pointed out where the new (or amended) claim is supported, nor does there appear

1   to be a written description of the claim limitations in the application as filed (see above

2   objection to the specification).

3
4
5   **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

6   The specification shall conclude with one or more claims particularly pointing out and distinctly
7   claiming the subject matter which the applicant regards as his invention.
8
9   **Claims 11, 14, 15, 17, 20, 21, and 23 rejected under 35 U.S.C. 112, second**

10   **paragraph, as being indefinite for failing to particularly point out and distinctly**

11   **claim the subject matter which applicant regards as the invention.**

12

13   Regarding claims 11 and 23, the examiner points out that they comprise

14   recitations failing to enable a complete and meaningful interpretation of the claims. The

15   examiner notes that the intended use recitations found within the claim preambles (i.e.

16   *"A security module for encrypting ... in a packet-oriented data network, and ... in a*

17   *public switched telephone network that is distinct from the packet-oriented data network*

18   *..."* [11]; *"A method for encrypting ... in a packet-oriented data network, and ... in a*

19   *public switched telephone network that is distinct from the packet-oriented data network*

20   *..."* [23]) each suggest that a "public switched telephone network" (admitted by the

21   applicant to be a digital ISDN – e.g. see par. 13) is somehow distinct from a packet-

22   oriented data network. The examiner notes that the meaning of such a recitation is

23   unknown to one of ordinary skill in the art as it is well known that networks, such as

24   digital ISDNs, <u>are</u> in fact packet oriented data networks (e.g. see evidence, Keller, par.

25   16; Schrodi, par. 5). Furthermore, applicants themselves attest to the fact that the

1   recited *"public switched telephone network"* transmits data packets (e.g. specification,

2   par. 25), thus being a "packet-oriented data network".

3

4   All depending claims are rejected by virtue of dependency.

5

6
7   ***Claim Rejections - 35 USC § 103***

8

9   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

10   obviousness rejections set forth in this Office action:

11   (a) A patent may not be obtained though the invention is not identically disclosed or described as set
12   forth in section 102 of this title, if the differences between the subject matter sought to be patented and
13   the prior art are such that the subject matter as a whole would have been obvious at the time the
14   invention was made to a person having ordinary skill in the art to which said subject matter pertains.
15   Patentability shall not be negatived by the manner in which the invention was made.
16
17   **Claims 11, 14, 15, 17, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as**

18   **being unpatentable over DiSanto et al. (DiSanto), U.S. Patent Publication**

19   **2003/0009659 in view of Blom et al. (Blom), "Conversational IP Multimedia**

20   **Security".**

21

22   Regarding claim 11, DiSanto discloses:

23   *a protocol processing unit processing messages of the key exchange protocol as*

24   *well as data packets transported on the packet-oriented network using the encrypted*

25   *transport protocol with keys for the encrypted transport protocol exchanged using a key*

26   *exchange protocol,, converting voice signals, created by the one of the first and second*

1   *telecommunication terminals at which said security module is connected, into data*

2   *packets for transport via the encrypted transport protocol and converting data packets,*

3   *arriving at said security module after transport via the encrypted transport protocol, into*

4   *voice signals* (DiSanto, fig. 2b:210,220; par. 31, 42, 43 – Herein DiSanto discloses

5   means for processing key exchange and encrypted data transport procedures [i.e.

6   "protocols"] for the purpose of encrypting and decrypting voice and data

7   communications between telecommunication terminals);

8   *a modem connection unit, used when said security module is connected in a*

9   *connecting line at a second telecommunication terminal, setting up a modem*

10   *connection between the second telecommunication terminal and at least one of the*

11   *gateway and another second telecommunication terminal, with the data packets being*

12   *transported using the encrypted transport protocol, along with messages of the key*

13   *exchange protocol, via the modem connection* (DiSanto, fig. 2b:240; fig. 4; par. 33).

14   *wherein a point-to-point protocol connection is used over the modem connection*

15   *in transporting the data packets using the encrypted transport protocol, as well as*

16   *messages of the key exchange protocol* (DiSanto, par. 41, 42 – herein DiSanto

17   discloses a procedure for establishing a direct connection between two nodes [i.e.

18   "point-to-point protocol connection"].

19   DiSanto discloses a security module designed to provide encrypted transport to

20   data between terminals within a network. DiSanto, however, does not appear to

21   explicitly recite *wherein the encrypted transport protocol is Secure Real Time Transport*

22   *Protocol.*

1   Blom discloses that applications for securely transmitting voice data through

2   networks, such as disclosed by DiSanto, should employ SRTP (Blom, Abstract). It

3   would have been obvious to one of ordinary skill in the art to employ the teachings of

4   Blom within DiSanto. This would have been obvious because one of ordinary skill in the

5   art would have been motivated by the teachings that such security protocols and

6   methods were designed specifically so as to improve the secure transport of voice and

7   data between communication terminals (Blom, Abstract; section 3).

8

9   Regarding claim 14, the combination enables:

10   *wherein the key exchange protocol is multimedia Internet keying* (Blom,

11   Abstract).

12

13   Regarding claim 15, the combination enables:

14   *wherein for a telephone conversation, messages of the key exchange protocol*

15   *are transported via a session initiation protocol, and wherein said protocol processing*

16   *unit processes the session initiation protocol* (Blom, section 2; section 5).

17

18   Regarding claim 17, the combination discloses that any conventional

19   communications system may be employed (DiSanto, par. 19). While the combination

20   does not appear to explicitly recite an ISDN communications system or the utilization of

21   the B channel of the ISDN system, the examiner notes that the employment of ISDN

22   and the B channel of ISDN were well known and implemented concepts to those of

1   ordinary skill in the art. One of ordinary skill in the art would have been motivated to

2   recognize ISDN and the utilization of communications over the B channel because such

3   system was conventional and its benefits were well recognized.

4

5   Regarding claim 20, the combination enables:

6   *wherein the packet-oriented network is an Internet protocol-based data network,*

7   *wherein the packet-oriented network is local area network* (DiSanto, par. 19), and *said*

8   *modem connection unit sets up the modem connection in accordance with at least one*

9   *of a V90 and a V92 standard* (DiSanto, par. 33).

10

11   Regarding claim 21, the combination enables:

12   *wherein said security module is connected into a connecting cable between a*

13   *telephone handset and the one of the first and second telecommunication terminals*

14   (DiSanto, fig. 1).

15

16   Regarding claim 23, it comprises essentially similar recitations as claim 11, and it

17   is rejected, at least, for the same reasons as claim 11.

18

19   ***Response to Arguments***

20

21   Applicant's arguments filed 10/7/10 have been fully considered but they are not

22   persuasive.

1

2   *Applicant argues or asserts essentially that:*

3   As such, the security module of claim 11 provides for end-to-end encryption

4   between a client in a packet-oriented network and a client in a public switched

5   telephone network (analog or digital), which is distinct from the packet-oriented network,

6   using the key exchange protocol and the encrypted transport protocol (SRTP) because

7   each of the two distinct networks <u>distinctly use</u> the key exchange protocol and the

8   encrypted transport protocol via the claimed protocol processing unit and modem

9   connection unit, respectively. These features are not taught by either DiSanto or Blom.

10   (Remarks, pg. 6)

11

12   *Examiner responds:*

13   First, the examiner respectfully notes that *"each of the two distinct networks*

14   *<u>distinctly use</u> the key exchange protocol and the encrypted transport protocol via the*

15   *claimed protocol processing unit and modem connection unit, respectively"* is not a

16   claim recitation.

17   Furthermore, it is respectfully noted that the applicant appears to misinterpret the

18   claim recitations. Specifically, it is <u>not</u> any network (such as the recited *"public switched*

19   *telephone network"* or *"packet-oriented data network"*) that **uses** the recited *the key*

20   *exchange protocol and the encrypted transport protocol*, but rather, it is the claimed

21   *security module* that **uses** such protocols.

1   Applicant's arguments are not appropriately presented, as the applicant fails to

2   clearly and specifically identify any particular claim recitation that the applicant feels is

3   missing from the prior art, and furthermore provide clear evidence or rational supporting

4   the applicant's position.   Applicant's arguments do not comply with 37 CFR 1.111(c)

5   because they do not clearly point out the patentable novelty which he or she thinks the

6   claims present in view of the state of the art disclosed by the references cited or the

7   objections made. Further, they do not show how the amendments avoid such

8   references or objections.

9

10   *Applicant argues or asserts essentially that:*

11   Thus, the modem 240 is used merely to comply with the technical requirements

12   of a respective network, but does not provide a technical solution enabling encryption of

13   voice data in a heterogeneous network including a packet-oriented network and a

14   PSTN.

15   (Remarks, pg. 7)

16

17   *Examiner responds:*

18   In response, the examiner respectfully reminds the applicant that the claim

19   recitations in question essentially pertain to a modem that provides a path for encrypted

20   communication (i.e. transports data according to the design of modem). This feature is

21   clearly shown within the prior art (e.g. DiSanto, fig. 2b:240; fig. 4; par. 33).

1   It is unclear what the applicant is trying to argue, however, the applicant appears

2   to suggest that the prior art modem doesn't perform some type encryption function.

3   However, the examiner respectfully reminds the applicant that the recited modem does

4   **not** perform *encryption of voice data in a heterogeneous network including a packet-*

5   *oriented network and a PSTN.* Rather, the recited modem is merely used to provide a

6   path for transporting any data.

7   Applicant's arguments are unpersuasive, at least, for the reason that they

8   essentially comprises only an allegation that the prior art "*does not provide a technical*

9   *solution enabling encryption of voice data in a heterogeneous network including a*

10   *packet-oriented network and a PSTN*".

11   In response to applicant's argument that the references fail to show certain

12   features of applicant's invention, it is noted that the features upon which applicant relies

13   (i.e., a modem that *provide a technical solution enabling encryption of voice data in a*

14   *heterogeneous network including a packet-oriented network and a PSTN*) are not

15   recited in the rejected claim(s).

16

17

18   *Applicant argues or asserts essentially that:*

19   However, unlike in DiSanto, the modem of the claimed security module enables

20   the data packets from the packet-oriented network to be transported using the

21   encrypted transport protocol, along with messages of the key exchange protocol, via the

22   modem connection. The procedure for establishing a direct connection between two

1   nodes in DiSanto does not anticipate or render obvious this type of connection among

2   terminals of different networks.

3   (Remarks, pg. 7)

4

5   *Examiner responds:*

6   First, the examiner respectfully notes that the applicant's arguments fail to

7   comprise any supporting rationale or evidence showing that the "modem" within the

8   prior art fails to transport data and messages of the key exchange protocol, wherein

9   such data has been encrypted according to the encrypted transport protocol.

10   Essentially, applicant's remarks comprise only an unsupported allegation, and for this

11   reason, at least, they are found to be unpersuasive.

12   The examiner respectfully notes that the applicant's allegation (e.g. *"The*

13   *procedure for establishing a direct connection between two nodes in DiSanto does not*

14   *anticipate or render obvious this type of connection among terminals of different*

15   *networks"*) fail to specifically identify and argue for the novelty of any particular claim

16   recitation. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they

17   amount to a general allegation that the claims define a patentable invention without

18   specifically pointing out how the language of the claims patentably distinguishes them

19   from the references.

20

21   *Applicant argues or asserts essentially that:*

1   It is respectfully submitted that the cited prior art does not teach each of the

2   features of claim 23, so that claim 23 patentably distinguishes over the prior art.

3   (Remarks, pg. 8)

4

5   *Examiner responds:*

6   Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount

7   to a general allegation that the claims define a patentable invention without specifically

8   pointing out how the language of the claims patentably distinguishes them from the

9   references.

10

11   ***Conclusion***

12

13   The prior art made of record and not relied upon is considered pertinent to

14   applicant's disclosure:

15   ***See Notice of References Cited.***

16

17   A shortened statutory period for reply is set to expire **3** months (not less than 90

18   days) from the mailing date of this communication.

19   Any inquiry concerning this communication or earlier communications from the

20   examiner should be directed to Jeffery Williams whose telephone number is (571) 272-

21   7965. The examiner can normally be reached on 8:30-5:00.

1   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

2   supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

3   number for the organization where this application or proceeding is assigned is (703)

4   872-9306.

5   Information regarding the status of an application may be obtained from the

6   Patent Application Information Retrieval (PAIR) system. Status information for

7   published applications may be obtained from either Private PAIR or Public PAIR.

8   Status information for unpublished applications is available through Private PAIR only.

9   For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

10   you have questions on access to the Private PAIR system, contact the Electronic

11   Business Center (EBC) at 866-217-9197 (toll-free).

12

13
14   /Jeffery Williams/
15   Examiner, Art Unit 2437
16
17   /Emmanuel L. Moise/
18   Supervisory Patent Examiner, Art Unit 2437
19